

REMARKS/ARGUMENTS

This paper is submitted in response to the Office Action having a mailing date of June 20, 2006. Claims 1-25 are pending in the current application. Claims 21-25 are withdrawn from consideration. Claims 26-29 are new. The specification has been amended to remove the reference to provisional application 60/397,191. The Examiner has rejected Claims 1-3, 10, and 12-15 as being anticipated under 35 U.S.C. § 102 (b) by U.S. Patent No. 2,825,329 to Caesar. Claims 4-9 and 16-19 stand rejected under 35 U.S.C. §103 (a) as being obvious in view of Caesar. Additionally, Claims 11 and 20 stand rejected under 35 U.S.C. §103 (a) as being unpatentable over U.S. Patent No. 5,487,741 to Maruyama et al in view of Caesar.

The present invention is directed to a device for stabilizing an image tracker in a patient's bone during surgery. The device includes a passageway defined by a first and second aperture disposed in axial alignment. The first and second axially aligned apertures receive a securing mechanism, such as a bone screw, that is temporarily inserted into a patient's bone. Additionally, the present invention includes a projection such as a pin used to prevent the device from rotating.

Rejections under 35 U.S.C. § 102 (b)

The Examiner has rejected Claims 1-3, 10, and 12-15 as being anticipated under 35 U.S.C. § 102 (b) by U.S. Patent No. 2,825,329 to Caesar. It is well recognized that claims are anticipated if, and only if, each and every element, as set forth in the claim is found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the...claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). See MPEP §2131. Applicant respectfully submits that the cited references do not disclose all of the material elements as required by the rejected claim language.

The invention disclosed by Caesar is directed to a device for internal fixation of bone fractures. The fixation device includes a metal plate 150 placed in contact with the external surface of the bone. The metal plate 150 includes two holes 156 for receiving two screws 158. In addition, two pins 152 are riveted to the ends of the metal plate 150.

While the invention disclosed by Caesar contains two holes, these holes are designed to receive two separate screws. In contrast, the present invention recites two holes, axially aligned to receive one screw. Applicant respectfully submits that Caesar fails to recite all the elements of the present invention as claimed. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 (b) is requested. In particular, the prior art fails to disclose at least the following italicized features of independent Claims 1 and 12.

1. A device for stabilizing an image tracker in a patient's bone, comprising:
a securing mechanism;
a body having a first aperture and a second aperture both sized to receive said securing mechanism;
wherein said securing mechanism is inserted through said first aperture and said second aperture and inserted into the patient's bone for temporarily stabilizing the image tracker to a patient.

12. A mounting base for stabilizing an image tracker in a patient's bone, comprising:
a body having *an entrance aperture and an exit aperture and a passageway therebetween*;

means for securing the base to the patient's bone, wherein said means for securing is sized to be received in said passageway; and

means for stabilizing the body from rotating; wherein said means for securing is inserted through said entrance aperture, said passageway, and said exit aperture and inserted into the patient's bone for temporarily stabilizing the image tracker to a patient.

Rejections under 35 U.S.C. § 103 (a)

The Examiner has rejected Claims 4-9 and 16-19 under 35 U.S.C. §103 (a) as being obvious in view of Caesar. Claims 11 and 20 stand rejected under 35 U.S.C. §103 (a) as being unpatentable over U.S. Patent No. 5,487,741 to Maruyama et al. in view of Caesar. To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), the Examiner must show that 1) the references teach all of the elements of the claimed invention, 2) the references contain some teaching, suggestion or motivation to combine the references, and 3) the references suggest a reasonable expectation of success. See MPEP §2142. See also *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000).

The invention disclosed by Maruyama is directed to a bone plate adapted to be attached to the surface of the bone. Maruyama discloses the use of flanges used in holes that receive bone screws. However, the combination of Maruyama and Caesar fails to teach at least the elements of independent Claims 1 and 12 discussed above. In particular, neither Maruyama nor Caesar disclose a device with axially aligned holes adapted to receive the same screw. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. §103 (a) is respectfully requested. Support for added claims 26-29 can be found, for example, on pages 5-8 of the specification and in Figs. 5-8b.

Amendment and Response to 6/20/06 Office Action
Application No. 10/624,234

Based upon the foregoing, Applicants believe that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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